

## **REMARKS**

### **Claim Status**

Applicants thank the Examiner, Mr. Phung-Hoang Nguyen, for the courtesies extended to applicants' representative during the telephone interview conducted on March 18, 2010, and for his assistance in furthering prosecution on the merits of the instant application. During the telephone interview, the subject matter of independent claims 1 and 9 were discussed. No agreement with respect to patentability of the claims was reached. The following remarks take into account the content of the telephone interview.

Applicants acknowledge, with appreciation, the indication that claims 5-6 and 8 contain allowable subject matter. Claims 1-17 are now pending, with claims 1 and 9 being in independent form. Dependent claim 12 has been amended. No new matter has been added. Reconsideration of the application, as herein amended, is respectfully requested.

### **Overview of the Office Action**

Claim 12 has been objected to based on a minor informality. Claim 12 has been amended in the manner suggested. Withdrawal of this objection is therefore deemed to be in order.

Claims 1-4, 7 and 9-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,320,026 ("*Adamczyk*") in view of U.S. Pub. No. 2002/0076027 ("*Bernnan*").

Applicants have carefully considered the Examiner's rejections and the comments provided in support thereof. For the following reasons, applicants assert that all claims now pending in the present application are patentable over the cited art.

**Patentability of the Independent Claims under 35 U.S.C. §103(a)**

The Examiner (at pg. 3 of the Office Action) acknowledges that *Adamczyk* fails to teach that “a prior test of the validity of the destination telephone number (NTEL) of the request (R) is executed automatically and locally to the requesting machine (H) relative to a telephone number database (BD) local to the requesting machine (H) in order to forward the request (R) from the requesting machine (H) to the domain name server only if its destination telephone number (NTEL) passes said test” as recited in independent claim 1 and correspondingly recited in independent claim 9, and cites *Bernnan* for this feature.

Applicants, however, contend that no combination of *Adamczyk* and *Bernnan* in fact achieves the subject matter of independent claims 1 and 9.

*Adamczyk* discloses a system in which the user 302 (e.g., a subscriber to a platform 308) communicates with the platform 308 over a public switched telephone network (PSTN) 312 (see col. 6, lines 58-60). *Adamczyk* (col. 6, line 66 to col. 7, line 4) explains that “[p]latform 308 also has a DNS server communications module 316 that communicates with a DNS/ENUM server and database system 318. In an embodiment, such communications occur over the Internet 320, but it is not required. The DNS server system receives requests and queries from the DNS server communications module 316”. *Adamczyk* thus teaches that the user platform 308 sends one or more requests for subscriber address information to DNS server 318, where the request identifies a telephone number for the subscriber.

Based on the teachings of *Adamczyk*, however, the platform 308 more aptly correlates to the requesting machine of independent claim 1, rather than the terminal 304 or 306 as asserted by the Examiner at pg 3, paragraph 4 of the Office Action. For example, *Adamczyk* (col. 7, lines 52-57) explains that “[o]nce received, the platform 310 also has a subscriber communications

module 330 for routing the message to the proper mailbox of the proper user, such as user 304 or user 306. Users 304 and/or 306 may then communicate with the platform 310 to retrieve any stored messages. With respect to user 306, such communication may occur via a PSTN 332 or some other communications network". The devices designated by reference characters 304 and 306 do not receive requests and queries from the DNS server. Devices 304 and/or 306 merely communicate with the platform 310 to retrieve stored messages.

*Adamczyk* further explains that the user platform 308 sends requests to DNS 318 without regard to the validity, *vel non*, of the telephone numbers contained in these requests (see col. 7, lines 3-4). Thus, there is no test of validity prior to forwarding (or not forwarding) of the request to the DNS server. As recognized by the Examiner, *Adamczyk* explains that "DNS/ENUM server 318 may perform any number of internal lookup functions and/or external requests to locate the LDAP database 322 associated with the provided phone number" (col. 7, lines 10-13). Put another way, the system of *Adamczyk* contains the same, old and well-known disadvantages of DNS servers that are described at pg. 1, lines 23-34 of the instant specification as originally filed. That is, the DNS server 318 of *Adamczyk* is burdened with the task of processing all requests from platform 308, including erroneous or invalid requests for which no domain name exists, thereby significantly reducing the speed and rate at which valid requests are processed. In fact, the *Adamczyk* system processes and sends all requests to DNS server 318 irrespective of the validity of the telephone numbers contained in the requests. *Adamczyk* thus teaches away from performing the prior test of validity as required in claim 1, because there is no reason whatsoever in *Adamczyk* to perform such a prior validity test.

Given that *Adamczyk* fails to teach or suggest that a validity test is performed locally to the requesting machine and that the validity test is performed prior to deciding whether a request

including the destination telephone number should be sent to the DNS, the Examiner seeks to cure this deficiency by citing *Bernnan*. The *Bernnan* system, however, fails to provide that which *Adamczyk* lacks. The skilled person is provided with no reason or motivation to consider the teachings of *Bernnan* to modify the *Adamczyk* method to achieve the method of independent claim 1, because there is no reason to perform a prior validity test in the *Adamczyk* system.

*Bernnan* describes “a method and system for fallback to message compose on a calling party’s own messaging system given an unsuccessful synchronous call attempt from the calling party to the called party” (see paragraph [0004], lines 1-4). In particular, *Bernnan* (paragraph [0036], lines 2-5) explains that “the supervisory system 48 supervises or monitors calls placed by the calling party’s communication device 42 and includes a message compose mode that allows a calling party to compose a message”. *Bernnan* thus teaches that “the supervisory system 48 monitors calls placed by the calling party’s communication device CD 42 and includes a message compose mode that allows a calling party to compose a message (see Fig. 3). As further explained in *Bernnan*, when a calling party 42 calls a party, the supervisory system 48 determines whether the call is answered (see paragraph [0038]; Fig. 3). If an actual human answers the call, the call proceeds in a conventional manner (see paragraph [0040]). If the call is unanswered or is answered by a messaging system, the supervisory system 48 retrieves, if available, user information for the called party from a database 50. *Bernnan* explains that the user information may include, for example, an alternate number/address for the called party that can be used for messaging (see, e.g., paragraphs [0026] and [0041] to [0042]).

Under the Examiner’s proffered analysis of the *Bernnan* system, applicants’ claimed requesting machine corresponds to the supervisory system 48 depicted in *Bernnan* Fig. 3. However, there is no DNS server described or suggested in *Bernnan*. In particular, the CD 42 of

the called party is not a DNS server. Rather, CD 42 is a conventional communication device, such as a computer or an advanced telephone. *Bernnan* thus fails to teach or suggest that a requesting machine forwards a request to a DNS server only if a test has first been passed.

Moreover, *Bernnan* fails to teach or suggest executing a test of the validity of a destination telephone number prior to deciding whether a request should be forwarded to a domain number server (DNS). As explained at paragraphs [0036] and [0040], the supervisory system 48 of *Bernnan* merely monitors calls between the calling party 42 and the called party, and consults a database 50 when the call is not answered. There is no prior execution of a validity test of the destination telephone number in *Bernnan*. Furthermore, there is no anticipation or contemplation in *Bernnan* of steps to take if the calling party fails to reach the called party because the dialed phone number is invalid (see, e.g., paragraph [0041] of *Bernnan*). There is accordingly no reason to attempt to perform a prior validity test to determine whether to send the request to a domain server.

The only “tests” taught in *Bernnan* are those in which the supervisory system 48 determines whether the call from the calling party is answered and, if the call is not answered, whether user information can be retrieved from the database 50. These tests do not however constitute validity tests of a destination telephone number. Moreover, these tests are not executed to determine whether a request should be forwarded to a DNS server. There is no request in *Bernnan* that contains a destination telephone number that is ever sent to the called party. Moreover, the cited art provides no reason whatsoever for the skilled person to so extensively modify the disclosed prior art methods and arrangements to provide a prior test of the validity of the destination telephone number of the request to forward the request from the requesting machine to the domain name server only if its destination telephone number passes

the test, absent an impermissible hindsight analysis based on applicants' own disclosure.

Independent claim 1 is therefore deemed to be patentable over the combination of *Adamczyk* and *Bernnan*, because – even assuming the propriety of the combination – *Bernnan* fails to provide that which *Adamczyk* lacks.

Independent claim 9 recites limitations similar to those of independent claim 1 and is, therefore, deemed to be patentably distinct over the combination of *Adamczyk* and *Bernnan* for *at least* those reasons discussed above with respect to independent claim 1.

By virtue of the above-discussed differences between the recitations of independent claims 1 and 9 and the teachings of *Adamczyk* in combination with *Bernnan*, and the lack of any clear motivation for modifying the reference teachings to achieve applicants' claimed invention, independent claims 1 and 9 are deemed to be patentable over the combination of *Adamczyk* and *Bernnan* under 35 U.S.C. §103.

### **Dependent Claims**

In view of the patentability of independent claims 1 and 9 for the reasons presented above, each of dependent claims 2-8 and 10-17 is respectfully deemed to be patentable therewith over the prior art. Moreover, each of these claims includes features which serve to still further distinguish the claimed invention over the applied art.

### **Conclusion**

Based on all of the above, applicants submit that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned to facilitate an early resolution of any outstanding issues.

Respectfully submitted,  
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